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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,237	06/19/2003	Timothy Regan	1026-090/MMM 303083.01	5539
27195 7590 02/08/2007 AMIN. TUROCY & CALVIN, LLP 24TH FLOOR, NATIONAL CITY CENTER 1900 EAST NINTH STREET CLEVELAND, OH 44114			EXAMINER BAYARD, DJENANE M	
			ART UNIT 2141	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	10/600,237		REGAN, TIMOTHY	
	Examiner		Art Unit	
	Djenane M. Bayard		2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/30/04, 11/23/04 and 10/11/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 21-25 and 27-29 are rejected under 35 U.S.C. 102(a) as being anticipated by European Patent Application No. EP 1 241 890 to Thomas.

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a. As per claim 21, Thomas teaches in an instant messaging system providing instant message communication between computers, multi-user computer instant messaging software in computer readable media, comprising: software for providing plural concurrent instant message user logins on a multi-user computer (See page 21, paragraph [0143] and page 36, paragraph [0142]) one of the plural concurrent instant message user logins being a registered buddy of a user of a second computer (See page 29, paragraph [0200]); and software for rendering on the multi-user computer a video display concurrently with the plural concurrent instant message user logins on the multi-user computer (See page

b. As per claim 22, Thomas teaches the claimed invention as described above. Furthermore, Thomas teaches rendering an instant message on the multi-user computer concurrently with the rendering of the video display (See page 23, paragraph [0160]).

c. As per claim 23, Thomas teaches the claimed invention as described above. Furthermore, Thomas teaches transmitting from the multi-user computer one of plural predefined instant messages (See page 17, paragraph [0120]).

d. As per claim 24, Thomas teaches the claimed invention as described above. Furthermore, Thomas teaches wherein predefined instant messages transmitted from the multi-user computer is selected by a user with a wireless remote control device (See page 19, paragraph [0130]).

e. As per claim 25, Thomas teaches the claimed invention as described above. Furthermore,

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Thomas teaches rendering an instant message on the multi-user computer over a portion of the video display without a visible window surrounding the instant message (See page 22, paragraph [0156]).

f. As per claim 27, Thomas teaches the claimed invention as described above. Furthermore, Thomas teaches wherein the instant message is rendered over a marginal region of the video display (See page 22, paragraph [0156]).

g. As per claim 28, Thomas teaches the claimed invention as described above. Furthermore, Thomas teaches wherein the instant message is rendered over a user-selectable portion of the video display (See page 22, paragraph [0156]).

h. As per claim 29, Thomas teaches the claimed invention as described above. Furthermore, Thomas teaches providing one of the plural concurrent instant message user logins on the multi-user computer as a guest login that does not correspond to a specific instant messaging user (See page 2, paragraph [0145]).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-4, 6-13, 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application No. EP 1 241 890 to Thomas in view of European Patent Application No. EP 1 130 869 To Mandato.

a. As per claims 1 and 11, Thomas teaches a messaging system providing instant message communication between computers, a multi-user computer instant messaging method, comprising the steps of: providing plural concurrent instant message user logins on a multi-user computer (See page 21, paragraph [0143] and page 36, paragraph [0142]), one of the plural concurrent instant message user logins being a registered buddy of a user of a second computer (See page 29, paragraph [0200]); However, Thomas fails to providing to the second computer an indication that the registered buddy is one of plural concurrent instant message user logins on a multi-user computer.

Mandato teaches a customizable logical user space, which subscribers can use for creating and/or modifying existing user profiles, depending on the changes in the environment in which they act (See page 11, lines 3-10 and page 17, lines 48-55)..

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the teaching of Mandato in the claimed invention of Thomas et al in order to allow the user to use different profiles for different situations (See page 7, line 27).

b. As per claims 2 and 20, Thomas in view of Mandato teaches the claimed invention as described above. Furthermore, Thomas teaches wherein one of the plural concurrent instant

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message user logins on the multi-user computer is a guest login that does not correspond to a specific instant messaging user (See page 21, paragraph [0145]).

c. As per claims 3 and 12, Thomas in view of Mandato teaches the claimed invention as described above. Furthermore, Thomas teaches wherein the multi-user computer renders a video display concurrently with the plural concurrent instant message user logins on the multi-user computer (See page 23, paragraph [0160]).

d. As per claims 4 and 13, Thomas in view of Mandato teaches the claimed invention as described above. Furthermore, Thomas teaches rendering an instant message on the multi-user computer over a portion of the video display without a visible window surrounding the instant message (See page 22, paragraph [0156]).

e. As per claims 6 and 15, Thomas in view of Mandato teaches the claimed invention as described above. Furthermore, Thomas teaches wherein the instant message is rendered over a marginal region of the video display (See page 22, paragraph [0156]).

f. As per claims 7 and 16, Thomas in view of Mandato teaches the claimed invention as described above. Furthermore, Thomas teaches wherein the instant message is rendered over a user-selectable portion of the video display (See page 22, paragraph [0156]).

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g. As per claims 8 and 17, Thomas in view of Mandato teaches the claimed invention as described above. Furthermore, Thomas teaches wherein the multi-user computer renders a video display concurrently with the plural concurrent instant message user logins on the multi-user computer and the method further comprises rendering an instant message on the multi-user computer concurrently with the video display (See page 22, paragraph [0156]).

h. As per claims 9 and 18, Thomas in view of Mandato teaches the claimed invention as described above. Furthermore, Thomas teaches transmitting from the multi-user computer one of plural predefined instant messages (See page 17, paragraph [0120]).

i. As per claims 10 and 19, Thomas in view of Mandato teaches the claimed invention as described above. Furthermore, Thomas teaches receiving from a wireless remote control device a user indication of the one of plural predefined instant messages transmitted from the multi-user computer (See page 19, paragraph [0130]).

7. Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application No. EP 1 241 890 Thomas in view of European Patent Application No. EP 1 130 869 To Mandato as applied to claims 1 and 11 above, and further in view of U.S. Patent Application No. 2004/0010808 to DeCarmo.

a. As per claims 5 and 14, Thomas in view of Mandato teaches the claimed invention as

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described above. However, Thomas fails to teach wherein the instant message is rendered with a user-discernible fade in and a user-discernible fade out.

DeCarmo teaches wherein the instant message is rendered with a user-discernible fade in and a user-discernible fade out (See page 5, paragraph [0044] and figure 7).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the teaching of DeCarmo in the claimed invention of Tomas in view of Mandato in order to allow the user to participate in instant messaging without unnecessarily distracting the user (See page 1, paragraph [0005]).

8. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application No. EP 1 241 890 Thomas in view of U.S. Patent Application No. 2004/0010808 to DeCarmo.

a. As per claim 26, Thomas teaches the claimed invention as described above. However, Thomas fails to teach wherein the instant message is rendered with a user-discernible fade in and a user-discernible fade out.

DeCarmo teaches wherein the instant message is rendered with a user-discernible fade in and a user-discernible fade out (See page 5, paragraph [0044] and figure 7).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the teaching of DeCarmo in the claimed invention of in order to allow the user to participate in instant messaging without unnecessarily distracting the user (See page 1, paragraph [0005]).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Application No. 2004/0143633 to McCarty teaches an instant Messaging system with privacy codes.

U.S. Patent No. 6, 301609 to Aravamudan et al teaches assignable associate priorities for user-definable instant messaging buddy groups.

U.S. Patent No. 2004/0117443 to Barsness teaches wherein a user may specify which indicia and which parameters may be used to infer his unavailability in an editable profile.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M. Bayard whose telephone number is (571) 272-3878. The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Djenane Bayard

Patent Examiner

KENNETH R. COULTER
PRIMARY EXAMINER

